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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/489,784	01/24/2000	Robert A Mohror	PO4345USO PHI 1191	6271

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EXAMINER

FOX, DAVID T

ART UNIT PAPER NUMBER

1638

DATE MAILED: 04/02/2002

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Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/488784

Applicant(s)

Mohr

Examiner

FOX

Group Art Unit

1638

—The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address—

## Period of Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

## Status

- ☒ Responsive to communication(s) filed on 1/18/02
- ☒ This action is FINAL.
- ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

## Disposition of Claims

- ☒ Claim(s) 1-32 is/are pending in the application.  
Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- ☒ Claim(s) 1-10, 12-14, 16-18, 20-23, 25-27, 29-31 is/are allowed.
- ☒ Claim(s) 11, 15, 19, 24, 28 and 32 is/are rejected.
- ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- ☐ Claim(s) \_\_\_\_\_ are subject to restriction or election requirement.

## Application Papers

- ☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
- ☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.
- ☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119 (a)-(d)

- ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
  - ☐ All ☐ Some\* ☐ None of the CERTIFIED copies of the priority documents have been received.
  - ☐ received in Application No. (Series Code/Serial Number) \_\_\_\_\_.
  - ☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_

## Attachment(s)

- ☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). \_\_\_\_\_
- ☐ Interview Summary, PTO-413
- ☐ Notice of Reference(s) Cited, PTO-892
- ☐ Notice of Informal Patent Application, PTO-152
- ☐ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Other \_\_\_\_\_

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The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Applicant's amendment of 18 January 2002 has overcome all rejections of record under 35 USC 112, second paragraph.

Claims 1, 5 and 7 remain objected to for their inclusion of blanks.

Applicant's intent on page 38 of the specification to deposit the exemplified maize seed in accordance with 37 CFR 1.801-1.809 is noted.

Claims 11, 15, 19, 24, 28 and 32 remain rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Roundy (U.S. 5,773,682), as stated in the last office action.

Claims 1-10, 12-14, 16-18, 20-23, 25-27 and 29-31 are deemed free of the prior art, given the failure of the prior art to teach or reasonably suggest a hybrid maize plant with the complete genetic and morphological complement of the instantly claimed hybrid, as argued by Applicant.

Claims 1-10, 12-14, 16-18, 20-23, 25-27 and 29-31 are allowed.

Applicant's arguments filed 18 January 2002, insofar as they pertain to the rejection above, have been fully considered but they are not persuasive.

Applicant urges that the rejection under 35 USC 102/103 is improper, given the lack of expectation of success that one of ordinary skill in the art could utilize the exemplified corn hybrid 31R88 as starting material for breeding a corn plant with at least two of the claimed traits, and

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given the unexpected nature of the combination of genetics and morphology of the exemplified corn hybrid 31R88 plant.

The Examiner maintains that the exemplified 31R88 hybrid plant would not be required in order to obtain a prior art plant which is genetically and phenotypically indistinguishable from the claimed plant, wherein such an indistinguishable plant may anticipate or render obvious the claimed plant produced by a different process, as taught by *Thorpe* cited previously. As stated previously, the rejected claims do not specify the number of generations of outcrossing or the nature of the other parent which was originally crossed with the exemplified 31R88 corn plant. It is well known in the plant breeding art that after six generations of outcrossing to a different parent, virtually no genetic material from the original plant remains. Thus, the claims read on a plant with no 31R88-derived genetic material, even if that hybrid was used at some point as an ancestor, particularly if more than six generations of crossing to a non-31R88 plant were employed.

Furthermore, the actual, individual claimed traits are not unique to 31R88, and at least two of these traits are present in a multitude of prior art corn plants. The degree of expression of individual traits such as disease resistance, yield, stay green, lodging resistance, etc. is not unique to 31R88. What makes 31R88 patentable, as noted by Applicants on page 9 of the response, is the unique combination of a multitude of quantitatively inherited traits present in that hybrid. However, this unique combination of traits and genetics is lost upon the first generation of outcrossing to a non-31R88 parent.

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**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to David T. Fox whose telephone number is (703) 308-0280. The examiner can normally be reached on Monday through Friday from 10:30AM to 7:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Amy Nelson, can be reached on (703) 306-3218. The fax phone number for this Group is (703) 872-9306. The after final fax phone number is (703) 872-9307.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0196.

March 29, 2002

DAVID T. FOX  
PRIMARY EXAMINER  
GROUP 180-1638

